

### REMARKS

This paper responds to the Final Office Action dated July 15, 2010. No claims are presently amended. Claims 1-32 were previously canceled, and no claims are canceled herein. No claims are presently added. As a result, claims 33-54 are now pending in this application.

#### *The Rejection of Claims Under § 103*

Claims 33-54 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fishkin et al. (U.S. Patent 5,841,437, "Fishkin") in view of Fowler et al. (U.S. Patent Application Publication 2002/01944166A1, "Fowler"). Applicants respectfully submit that a determination of obviousness is not established for the reason that the scope and content of the cited references, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements.

A determination of obviousness requires a factual showing that "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."<sup>1</sup> "The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, . . . secondary considerations."<sup>2</sup>

Moreover, according to the U.S. Circuit Court of Appeals for the Federal Circuit (CAFC), when determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – including **all its limitations** – with the teaching of the

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<sup>1</sup> *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

<sup>2</sup> *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467, *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406-7, 82 U.S.P.Q.2d 1385, 1390 (2007), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential).

prior art.”<sup>3</sup> **“All words in a claim must be considered in judging the patentability of that claim against the prior art.”**<sup>4</sup>

Furthermore, inherency of a claim element “requires that the missing descriptive material is **‘necessarily present,’** not merely **probably or possibly** present, in the prior art.”<sup>5</sup> “The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient.”<sup>6</sup>

Each of independent claims 33, 43, and 53-54 recites, in part, **“receiv[ing] a first selection from the user via the first search interface, the first selection indicating the first search criteria as selected for inclusion in the first search query and indicating the second search criteria as deselected from inclusion in the first search query.”**<sup>7</sup> Considering all words in the independent claims, the first selection is being received, and the first selection indicates two things. Specifically, the two things indicated are (1) that the **first search criteria are selected for inclusion in the search query** and (2) that the **second search criteria are deselected from inclusion in the same search query.**

The Final Office Action contains no discussion of **receiving a first selection that indicates two things**, let alone **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query.** As a result, this claim element is unaddressed in the Final Office Action. Applicants respectfully submit that this claim element is absent from the combination of Fishkin and Fowler.

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<sup>3</sup> *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995), emphasis added; *see also Ex Parte Wada and Murphy*, Appeal No. 2007-3733 (BPAI 2008).

<sup>4</sup> *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970), emphasis added; *see* MPEP § 2143.03.

<sup>5</sup> *In re Robertson*, 169 F.2d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999), citing *Continental Can Co. USA, Inc., v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991), emphasis added.

<sup>6</sup> *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981), emphasis added; *see also Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (BPAI 1986) (“[T]he Examiner must provide some evidence or scientific reasoning to establish the reasonableness of the Examiner’s belief that the functional limitation is an **inherent** characteristic of the prior art’ before the burden is shifted to the Applicant to disprove inherency,” emphasis added).

<sup>7</sup> Emphasis added.

Therefore, the scope and content of Fishkin and Fowler, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 33, 43, and 53-54, and their respective dependent claims 34-42 and 44-52. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

Moreover, the Final Office Action conceded that “Fishkin does not specifically or expressly recite . . . indicating the second search criteria as deselected from inclusion in the first search query.”<sup>8</sup> Applicants agree. The Final Office Action, however, cited to FIGS. 3a-3b, and paragraphs 0040-0041, 0044-0045, and 0049 of Fowler as allegedly teaching this claim limitation.<sup>9</sup> In actuality, Fowler makes no mention of indicating second search criteria as deselected from inclusion in the first query, much less **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query.**

Prior art must be considered **in its entirety**.<sup>10</sup> When considered in its entirety, Fowler merely describes a “sifter”<sup>11</sup> of search results that “aids the user in **sifting** through a list of search results from a search query.”<sup>12</sup> Fowler explicitly states that the **results** are from a search query<sup>13</sup> and that it is the **results** that are sifted,<sup>14</sup> not the search query. According to Fowler, “[t]he effect of the sifting algorithm is to **exclude** unwanted **results** from the derived list [of search

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<sup>8</sup> Final Office Action at 4-5.

<sup>9</sup> *Id.* at 5.

<sup>10</sup> *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); see MPEP § 2141.02(VI), (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,” emphasis added).

<sup>11</sup> Fowler at FIG. 3a, “The Thistle Sifter,” emphasis added.

<sup>12</sup> *Id.* at Abstract, emphasis added.

<sup>13</sup> *Id.*

<sup>14</sup> *Id.* at paragraph 0041, “the minimal set of available **sifting** operations are to . . . ‘**exclude**’ from the list of search results,” emphasis added.

results].”<sup>15</sup> Excluding results, even if the results come from a search query, is not the same as **indicating search criteria as deselected from inclusion in a search query**. Results are not the same as criteria, and search results are not the same as search criteria. Hence, excluding search results is not the same as deselecting search criteria from inclusion in a search query, let alone indicating search criteria as deselected from inclusion in a search query.

Although Fowler mentions “**exclud[ing]** from the list of search results those **documents** containing [a] given keyword,”<sup>16</sup> excluding a document from search results is not the same as **indicating search criteria as deselected from inclusion in a search query**. As noted above, results are not the same as criteria, and search results are not the same as search criteria. Similarly, results are not a query, and search results are not the same as a search query. Furthermore, a document does not constitute search criteria or a search query. Hence, the discussion in Fowler of excluding a document from search results is silent with respect to **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query**.

Fowler also describes “extracting . . . **keywords from the results** . . . [and] allowing the user to select keywords and apply sifting operations to those keywords.”<sup>17</sup> While Fowler discusses ““**exclud[ing]**’ selected **keywords**, which would result in the search **results** being sifted,”<sup>18</sup> consideration of Fowler in its entirety requires recognizing that the keywords of Fowler are extracted from search results and used to exclude unwanted search results.<sup>19</sup> Mere mention of “keywords” does not inherently discuss search criteria in a search query, at least because there is no necessity that all keywords must be search criteria in a search query. Extracting keywords from search results has nothing to do with **indicating search criteria as deselected from inclusion in a search query**. As noted above, sifting search results is not the same as indicating search criteria as deselected from inclusion in a search query. Hence, the discussion in Fowler of

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<sup>15</sup> *Id.* at paragraph 0042, emphasis added.

<sup>16</sup> *Id.* at paragraph 0041, emphasis added.

<sup>17</sup> *Id.* at Abstract, emphasis added.

<sup>18</sup> *Id.* at paragraph 0049, emphasis added.

<sup>19</sup> *Id.* at Abstract.

extracting keywords from search results is silent with respect to **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query.**

FIG. 3a and FIG. 3b of Fowler explicitly illustrate an “original search query . . . for the term ‘bond’.”<sup>20</sup> Nothing in Fowler mentions receiving a first selection that indicates first search criteria as selected for inclusion in this search query and that indicates second search criteria as deselected from inclusion in this search query. The cited figures of Fowler also illustrate a list of “Result[s]”<sup>21</sup> and a list of “Keyword[s].”<sup>22</sup> As noted above, the results of Fowler are not the same as search criteria in a search query, and the keywords of Fowler are not the same as search criteria in a search query. Thus, the cited figures of Fowler fail to support the instant rejections.

Paragraphs 0040-0041, 0044-0045, and 0049 of Fowler merely discuss “exclud[ing] . . . documents,”<sup>23</sup> “sifting . . . the search results,”<sup>24</sup> “keywords extracted from the results . . . [and] exclud[ing] selected keywords,”<sup>25</sup> all of which have been analyzed above. The cited paragraphs therefore do not support the instant rejections. Considering Fowler in its entirety, nothing in the entirety of Fowler makes any mention of **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query.** As a result, Fowler fails to support the instant rejections.

The Final Office Action cited to FIGS. 5-7 of Fishkin as allegedly teaching “drop-down menus and combo-boxes that allow the user to make **query selections.**”<sup>26</sup> Even if this allegation were hypothetically true, mere mention of query selections fails to discuss **indicating search criteria as deselected from inclusion in a search query.**

<sup>20</sup> *Id.* at FIG. 3a and paragraph 0048, emphasis added.

<sup>21</sup> *Id.*, emphasis added.

<sup>22</sup> *Id.*, emphasis added.

<sup>23</sup> *Id.* at paragraph 0041.

<sup>24</sup> *Id.* at paragraph 0044.

<sup>25</sup> *Id.* at paragraph 0049.

<sup>26</sup> Final Office Action at 5, emphasis added.

While FIG. 5 of Fishkin depicts “buttons [that] allow for interactive alteration of the selected composition mode of [a viewing operation region (VOR)],”<sup>27</sup> mere discussion of interactive alteration makes no mention of **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query.**

FIG. 6 of Fishkin illustrates “a query . . . for cities which have high annual salaries and low taxes,”<sup>28</sup> and FIG. 6b of Fishkin illustrates “which cities have either high salaries OR low taxes.”<sup>29</sup> Mere discussion of using “and” or “or” in queries says nothing about **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query.**

FIG. 7 of Fishkin depicts “simultaneous multiple queries”<sup>30</sup> and “a use of multiple visual filters to aid in viewing the data.”<sup>31</sup> However, nothing in FIG. 7 of Fishkin indicates search criteria as deselected from inclusion in a search query, let alone **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query.**

Moreover, the Final Office Action conceded that “Fishkin does not specifically or expressly recite . . . indicating the second search criteria as deselected from inclusion in the first search query,”<sup>32</sup> as noted above. Applicants agree with the Examiner that Fishkin is silent with respect to **receiving a first selection that indicates first search criteria as selected for inclusion in a search query and that indicates second search criteria as deselected from inclusion in the same search query.**

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<sup>27</sup> Fishkin at FIG. 5 and column 18, lines 50-51.

<sup>28</sup> *Id.* at FIG. 6a and column 19, lines 4-5.

<sup>29</sup> *Id.* at FIG. 6b and column 19, lines 8-11.

<sup>30</sup> *Id.* at FIG. 7 and column 19, lines 23-24.

<sup>31</sup> *Id.* at column 19, lines 26-27.

<sup>32</sup> Final Office Action at 4-5.

For at least these reasons, the scope and content of Fishkin and Fowler, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 33, 43, and 53-54, and their respective dependent claims 34-42 and 44-52. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

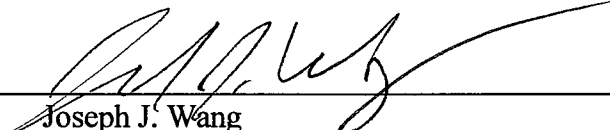
If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 9-14-2010

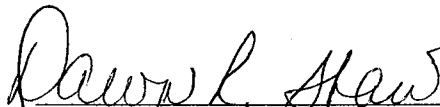
By

  
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Dawn R. Shaw

Name

  
Signature